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EXAMINER
SCHMIDT, KARI L

ART UNIT	PAPER NUMBER
2139	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

AK

	Application No.	Applicant(s)
Office Action Summary	10/790,901	SMITH ET AL.
	Examiner	Art Unit	
	Kari L. Schmidt	2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 October 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

    4a) Of the above claim(s) <u>34 and 35</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-33</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>01 March 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/29/2007</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

This communication is in response to the amendment filed on 10/29/2007. Claims 1-35 remain pending. Claims 1, 2, and 23 have been amended. Claims 25-35 are added. The examiner maintains the same grounds of rejection for claims 25-28 and 30-33 based on applicant's admission that these claims are similar to those of claims 1-24. The examiner establishes new grounds of rejection for claim 29. The examiner restricts claims 34 and 35 based on applicant's admission that claims 34 and 35 are subject to restriction as per MPEP § 821.03.

Election/Restrictions

Newly submitted claims 34 and 35 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: forming a package based on a policy to the package and applying a policy to the package

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34 and 35 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Terminal Disclaimer

The terminal disclaimer filed on 10/29/2007 disclaiming the terminal portion of

any patent granted on this application which would extend beyond the expiration date of

U.S. Patent 6,826,609 has been reviewed and is accepted. The terminal disclaimer has

been recorded.

Response to Arguments

Applicant's arguments filed 10/29/2007 have been fully considered but they are

not persuasive.

The applicant argues that Schutzman fails to teach a situation in which delivery is

conditioned of.on particulars or policy data associated with the sender enterprise.

The examiner disagrees. The examiner notes Schutzman discloses a situation in

which delivery is conditioned of on particulars or policy data associated with the sender

enterprise (see at least, abstract and col. 3, lines 18-24). The examiner notes that

Schutzman teaches particular events may be associated with a specific mail message,

and/or rules... thus only mail messages and relevant rules (i.e. those having an

associated satisfied even need to be further processed) (see at least, col. 3, lines 18-

24). Further the user (e.g. sender) can invoke structured rules and rule sets (see at

least, col. 3, lines 29-34). The examiner interprets the following teachings to be a user

creating a message with a particular rule set. Further Schutzman discloses "WHEN

READ" event which executes the rules set forth   by the user (e.g. sender) of the original

message as noted above (see at least, and col. 3, lines 18-24 and col. 3, lines 29-34).

The examiner notes under the broadest reasonable interpretation Schutzman teaches a

situation in which delivery is conditioned on the policy data associated with the sender

enterprise. Therefore this argument is not persuasive.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17, 20, 25-27 and 30-32 are rejected under 35 U.S.C. 102(b) as being

anticipated by Schutzman et al. (US 5, 627, 764).

Claims 1, 25, 26, 27, 30, 31 and 32

Schutzman discloses a computer readable medium useful in association with a

computer which includes a processor and a memory, the computer readable medium

including computer instructions which are configured to cause the computer to assure

adherence to a policy by a package to be delivered from a sender associated with an

enterprise to one or more recipients through a computer network by (column 6, lines 15-

25: client-server architecture is implemented... various rule mechanism resources and

the user interface are served by a messaging transport access layer..):

responsive to receipt package data which is generated by the sender and which

specifies the package (column 3, lines 15-25: mail messaging system with particular

events may be associated with a specific mail message and rules...), applying a policy

to the package wherein the policy is specified by policy data received from a policy

authority of the sender the policy authority including a rule base associated with the

sender enterprise(column 3, lines 15-25: mail messaging system with particular events

may be associated with a specific mail message and rules...);

determining whether the policy permits delivery of the package (Column 6, lines 25-35:

mail application running with the network software, facilitating mail message access

between the rule mechanism resources.. rule mechanism resources implement actions

on a mail message based upon an evaluation of a condition, effected upon the

occurrence of a particular event..); upon a condition in which the policy permits delivery

of the package, delivering the package by (column 6, lines 15-25: client-server

architecture is implemented.. various rule mechanism resources and the user interface

are served by a messaging transport access layer..):

sending notification to the recipients wherein the notification includes package

identification data (column 7, lines 15-25); and

responsive to receipt the package identification data from a selected one of the

recipients (column 7, lines 15-25),

providing the selected recipient in with access to the package (column 7, lines 15-25).

Claim 2

Schutzman discloses the computer readable medium of Claim 1 wherein the policy

applying comprises: determining that the package satisfies one or more conditions; and

if the package satisfies the one or more conditions, performing one or more actions

which are associated with the one or more conditions (column 3, lines 35-40: rule

application limiting message kinds... which can be used to further limit the application of

rules when the even occurrence specified... limited by the repertoire of forms).

Claim 3

Schutzman discloses the computer readable medium of Claim 1 wherein the one or

more actions block delivery of the package (column 14, lines 35-40: prompts the user to

specify a message limit for folders... which when tested may result in the action of

deleting messages from the folder...).

Claim 4

Schutzman discloses the computer readable medium of Claim 1 wherein the one or

more actions block delivery of the package pending review of the package by the policy

authority (column 7, lines 50-67 and column 8, lines 5-15: trigger a rule.. a rule pointer

or tag which points to a rule in a rule data base for invocation of an action or sequence

of action...).

Claim 5

Schutzman discloses the computer readable medium of Claim 2 wherein the one or

more actions document the delivery of the package (column 20, lines 20-25: information

logged to the log file is available for viewing and can include a log of users....).

Claim 6

Schutzman discloses the computer readable claim of Claim 5 wherein the one or more

actions document the delivery of the package by storing a copy of the package (Figure

16).

Claim 7

Schutzman discloses the computer readable medium of Claim 5 wherein the one or

more actions document the delivery of the package by sending a copy of the package to

a predetermined recipient (Column 13, lines 60-67: new messages can be forwarded or

replied to automatically... user interacts with templates..).

Claim 8

Schutzman discloses the computer readable medium of Claim 2 wherein at least a

selected one of the one or more actions notifies at least one predetermined recipient of

one or more others of the one or more actions (Column 20, lines 15-25: status

information that can be presented by the status display manager... user-list-file from

which users are being processed.. list box displays the users in the user-list-file.. status

messages fro the user currently being processed are reported...)

Claim 9

Schutzman discloses the computer readable medium of Claim 8 wherein the

predetermined recipient is the sender (Column 13, lines 50-60: auto forward facility, like

the message clerk, permits specification of conditions for testing the forms, senders and

subject matter of a new message... forwarded messages can be sent with added text to

the recipient whereas the resent messages is sent as a new message..).

Claim 10

Schutzman discloses the computer readable medium of Claim 2 wherein the one or

more actions modify the package (Column 10, lines 1-10: messages, events and rules

and assures that only relevant rules and associated messages are further process by a

rule engine... modify).

Claim 11

Schutzman discloses the computer readable medium of Claim 10 wherein the one or

more actions modify the package by removing one or more data files attached to the

package (Column 13, lines 5-25: implementing rule editors..).

Claim 12

Schutzman discloses the computer readable medium of Claim 1 (original) wherein the

one or more actions modify the package by modifying a message within the package

(Column 7, lines 44-52: when new, read and filed event limitations can be further

limited, to limit application of rules of message kinds...).

Claim 13

Schutzman discloses the computer readable medium of Claim 10 wherein the one or more actions modify the package by modifying data which specifies the manner in which the package is to be delivered (Column 7, lines 44-52: when new, read and filed event limitations can be further limited, to limit application of rules of message kinds...).

Claim 14

Schutzman discloses the computer readable medium of Claim 10 wherein the one or more actions modify the package by modifying data which specifies recipient actions which can be performed on the package after receipt by the recipient (Column 13, lines 50-65: auto forward facility, like the message clerk, permits specification of conditions for testing the forms, senders and subject matter of a new message... forwarded messages can be sent with added text to the recipient whereas the resent messages is sent as a new message..).

Claim 15

Schutzman discloses the computer readable medium of Claim 2 wherein the one or more conditions include a boolean expression involving data related to the sender (Column 7, lines 1-10).

Claim 16

Schutzman discloses the computer readable medium of Claim 2 wherein the one or more conditions include a boolean expression involving data related to one or more of the recipients (Column 16, lines 25-40: rule can be triggered upon a message being FILED according to a FILDED message event..).

Claim 17

Schutzman discloses the computer readable medium of Claim 2 wherein the one or more conditions include a boolean expression involving data related to one or more attributes of the package (Column 14, lines 30-40: "folder clerk" structured rule editor invoked in accordance with either a startup or periodic event... figure 10f.. prompts the user to specify a message limit for folder...).

Claim 20

Schutzman discloses the computer readable medium of Claim 1 wherein the policy data is received from the policy authority through a computer network (column 17, lines 35-60: components of the rule based messaging system having automated messaging and feedback described can be implemented as a server based process... functionality.. network operating system..).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 18-19, 21-24, 28, and 33 are rejected under 35 U.S.C. 103 (a) as being

unpatentable over US Patent 5, 627, 764 by Schutzman et al in view of US Patent 6,

275, 937 by Hailpern et al.

Regarding claim 18, Schutzman teaches all the limitation but does not teach

about using a web browser. The knowledge of web browsers is well known in the art

and this is demonstrated in Hailpern teaching, (Column 1, lines 40-67 and Column 2,

lines 1-67). It would have been obvious at the time of invention for some one of

ordinary skill to use a web browser as a user interface (Schutzman, Figures 1 & 14).

The World Wide Web is the cheapest and common means for data

communication around the world (Column 2, lines 65-67. Because of the web

popularity, there are standards that are incorporated to insure compatibility between the

many users. These standards are HTML (Column 1, lines 35-40), HTTP (Column 1,

lines 40-55), URL (Column 2, lines 35-55), and SMTP (Column 12, lines 45-55). It

would be more economical to use a browser that is compatible to the all the popular

standards. Browsers of this kind are more common, well supported and cost less than

a non-standard browser. A standard browser allows the user to communication with a

majority of users on the World Wide Web.

Regarding claim 19, the computer readable medium of Claim 18 wherein the

package data is HTML form data (covered in claim 18).

Regarding claim 21, the computer readable medium of Claim 1 wherein the

computer network is the Internet (covered in claim 18).

Regarding claims 22, 24, 28, and 33, the computer program product of claim 27,

further comprising: a hypertext transfer protocol (HTTP) type interface for sender

interaction with the server; and a simple mail transfer protocol (SMTP) type interface for

supply of a notification message to the particular recipient (covered in claim 18).

Regarding claim 23, the computer readable medium of Claim 1 wherein the

package identification data is supplied as part of a URL (covered in claim 18).

Claims 29 is rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent 5,

627, 764 by Schutzman et al in view of US Patent 6, 202,157 by Brownlie et al.

Regarding claim 29, Schutzman teaches all the limitation but does not teach

about using a secure socket layer (SSL) protocol.

The knowledge of secure socket layer (SSL) protocol is well known in the art and

this is demonstrated in Brownlie teaching, (Column 7, lines 66-67 and Column 8, lines

1-24).

It would have been obvious at the time of invention for some one of ordinary skill

to use secure socket layer (SSL) protocol as taught by Brownlie. One of ordinary skill in

the art would have been motivated to combine the teachings in order to enforce

unilateral security of data between network nodes (see at least, Brownlie: Column 7,

lines 66-67 and Column 8, lines 1-24).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kari L. Schmidt whose telephone number is 571-270-1385. The examiner can normally be reached on Monday - Friday: 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KS

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